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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/423,916    02/28/00    METELSKI

A    288.999651

EXAMINER

024041    PM82/0426  
SIMPSON SIMPSON & SNYDER. LLP  
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MARSH, S  
ART UNIT

PAPER NUMBER

3632  
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04/26/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/423,916

Applicant(s)

METELSKI ET AL.

Examiner

Steven Marsh

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is the first office action for US application 09/423,916 for a Microscope Stand, Especially for an Operation Microscope filed by Andreas Metelski et al. on February 28, 2000.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 42 and 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Figures 5-7 and page 14 of the specification fail to adequately explain how to operate the length adjustment (102), chain (101), and gears (105) to lower the positioning feet (100).

### ***Allowable Subject Matter***

Claim 43 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The prior art discloses a microscope stand with a positioning means for

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lowering a plurality of feet, but it does not disclose the positioning means as a plurality of gear wheels, used in conjunction with a chain and a method for driving the chain.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14-39, 44 and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,162,523 to Metelski et al. in view of U.S. Patent No. 5,425,068 to Schaefer et al.. Claim 1 of the '523 patent claims a microscope stand comprising a plurality of connected elongated support arms (1,2,4,16,40). Each arm is made of a fiber-reinforced composite material (preferably plastic, see fig.3), wherein each arm includes an interface (96) dividing the arm into two adjacent parts which prevents transfer of stress from one of the arms to the other. The only difference between Claim 1 of the '523 patent and Claims 14, 15, and 24 of the present application, is that the support

arms of the present application utilize a composite structure consisting of metal and fiber reinforced plastic tubes rather than just using fiber reinforced plastic tubes.

Schaefer et al. discloses an aluminum extruded profile (14) that is glued, riveted, or rolled to a surrounding, fiber reinforced plastic (12) for the purpose of absorbing anticipated loads. Schaefer et al. does not explicitly state that the purpose of surrounding the aluminum extruded profile with a fiber reinforced plastic is to optimize weight/vibration behavior (instead citing cost), but that is accomplished by the design. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have used a composite structure tube of aluminum and fiber reinforced plastic, as taught by Schaefer et al., instead of the fiber reinforced plastic tube taught by Metelski et al., for the purpose of providing a strong, lightweight support member.

Claims 16-23, and 25-27 related to the fiber reinforced plastic tube and are anticipated by Claims 2-15 of the '523 patent. Schaefer et al. does not disclose cementing as the method for connecting the aluminum extrusion and the fiber reinforced plastic, but the choice to use glue or cement is a matter of engineering preference, therefore Claims 28-30 are also rejected. Claims 31-36 are rejected in light of Claims 21 and 22 which claim an interface including a damping interlayer, made of an elastomeric material, for reducing transfer of vibration energy between adjacent parts. Claims 37 and 38 are rejected because the '523 patent discloses both a plurality of wheels (25b) and a plurality of positioning feet (column 5, line 58).

Claims 40 and 41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S.

Patent No. 6,162,523 in view of Schaefer et al., in further view of U.S. Patent 4,690,960 to Yamauchi et al. The '523 patent does not disclose a base consisting of two plates rigidly connected around a honeycomb structure. Yamauchi et al. discloses a bed for supporting a microscope (see Column 1, lines 16-25). The bed consists of two plates (72 and 73) fastened around an aluminum honeycomb structure by an adhesive. It would have been obvious to one of ordinary skill in the art at the time of the present invention, to have utilized the teaching of Yamauchi et al. and insert a honeycomb structure in the base taught by the '523 patent, for the purpose of providing a lightweight, vibration dampening base. The features of Claims 44 and 45 are well known to a person of ordinary skill in the art.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-39, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,609,316 to Tigliev in view of Schaefer et al. Tigliev discloses a microscope stand having a plurality of support members (30,34,40). The support members are connected by metallic interfaces that form a stress free connection between the adjacent parts. The stand has either positioning feet or wheels (see column 2, line 47) and elastomeric pads can be provided as a damping layer

between either the wheels and the base (see column 2 line 46) or the base and the floor.

Schaefer et al. discloses an aluminum extruded profile (14) that is glued, riveted, or rolled to a surrounding, fiber reinforced plastic (12) for the purpose of absorbing anticipated loads. Schaefer et al. does not explicitly state that the purpose of surrounding the aluminum extruded profile with a fiber reinforced plastic is to optimize weight/vibration behavior (instead citing cost), but that is accomplished by the design. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have used a composite structure tube of aluminum and fiber reinforced plastic, as taught by Schaefer et al., instead of the fiber reinforced plastic tube taught by Tigliev, for the purpose of providing a strong, lightweight support member. Claims 19-23 and 25-27 are a matter of engineering preference and are therefore obvious. (also see Schaefer et al, column 2, line 55). The features of Claims 44 and 45 are well known to a person of ordinary skill in the art.

Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tigliev in view of Schaefer et al, in further view of U.S. Patent 4,690,960 to Yamauchi et al. Tigliev in view of Schaefer et al. does not disclose a base consisting of two plates rigidly connected around a honeycomb structure. Yamauchi et al. discloses a bed for supporting a microscope (see Column 1, lines 16-25). The bed consists of two plates (72 and 73) fastened around an aluminum honeycomb structure by an adhesive. It would have been obvious to one of ordinary skill in the art at the time of the present invention, to have utilized the teaching of Yamauchi et al. and insert a

honeycomb structure in the base taught by Tigliev, for the purpose of providing a lightweight, vibration dampening base.

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tigliev in view of Schaefer et al, in further view of U.S. Patent 3,637,233 to Hoppl et al. Tigliev in view of Schaefer et al. does not disclose a positioning means for lowering the feet of the base. Hoppl et al. disclose a microscope stand with a base, which has wheels (41 and 43) and feet (36 and 37), as well as a means for simultaneously lowering the feet (54). It would have been obvious to one of ordinary skill in the art at the time of the present invention to have utilized the base taught by Hoppl et al., with the microscope stand taught by Tigliev in view of Schaefer et al., for the purpose of providing a microscope stand with a means for switching between mobile and stationary.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 5,173,802 to Heller

U.S. Patent 6,070,839 to Brenner et al.

U.S. Patent 5,825,536 to Yasunaga et al.

U.S. Patent 3,891,301 to Heller

U.S. Patent 5,528,417 to Nakamura


The above patents all disclose different types of microscope stands.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Marsh whose telephone number is (703) 305-0098. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30 PM. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

*SM*  
Steven Marsh

April 20, 2001

  
LESLIE A. BRAUN  
SUPERVISORY PATENT EXAMINER